UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,580	02/12/2001	Mark S. Coronna	11416-723001	9719

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EXAMINER
DASS, HARISH T

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/781,580	CORONNA ET AL.
	Examiner	Art Unit	
	Harish T. Dass	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 March 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-58* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Remington

et al (hereinafter Remington – US 6,070,150) in view of Kolling et al (hereinafter Kolling

– US 5,920,847) and Chevy Chase Bank "Checy Chase Bank - Automated Banking

Services Terms and Conditions" 19996 (hereinafter Chevychase).

Re. Claims 1, 24, Remington discloses receiving a payment request at a computer in a

payment system indicating that the payor has authorized payment to the payee [see

entire document particularly, Abstract; C6 L10-L23; claims 1-11], selecting payment

account & instruction [C14 L23-L35], executing the payment request to cause a first

payment to be made from the payor and a second payment to be made to the payee,

payment configuration [Figures 4-5; C2 L35-L57; C15 L1-L17; C15 L42-L67; C19 L12 to

C20 L55]. Remington does not explicitly disclose configuring a payment transaction by

selecting a payment method for the payor from a first set of payment methods using a

payment rule, wherein the selected payment method is independent of a payment

method selected for the payee.

Methods available for the transaction in the payment system.

However, Kolling discloses configuring a payment transaction by selecting a payment method for the payor from a first set of payment methods using a payment rule, wherein the selected payment method is independent of a payment method selected for the payee [Abstract; Figures 9-19; C L1-L37; C15 L55 to C16 L43; C31 L12-L53] to accommodate differing consumer preferences. Chevychase disclose "Bill Payment" and Methods available for the transaction in the payment system [see enclosed selected pages 1-5; see "you can arrange current, future and recurring bills from bill payment account"] to allow home banking using Internet to pay bills. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Remington and include configuring a payment transaction by selecting a payment method for the payor from a first set of payment methods using a payment rule, wherein the selected payment method is independent of a payment method selected for the payee, as disclosed by Kolling, to allow participating consumer (payee) to pay bills according to preset rules and differing configuration for different financial institutions and differing consumer preferences, and include Methods available for the transaction in the payment system, as disclosed by Chevychase, to allow home banking using Internet to pay bills with different preferences.

Re. Claims 2-4, and 25-27, Remington does not explicitly disclose wherein the payment rule is a predetermined business rule, wherein the predetermined business rule is accessed from a database containing payee information and payor information, and is selected as a function of pre-negotiated terms between the payee and the payor,

wherein the predetermined business rule selects a payment method according to the
amount of the payment. However, Kolling discloses wherein the payment rule is a
predetermined business rule (preset and defined set of rules), wherein the
predetermined business rule is accessed from a database containing payee information
and payor information, and is selected as a function of pre-negotiated terms between
the payee and the payor, and wherein the predetermined business rule selects a
payment method according to the amount of the payment [Abstract; C3 L63 to C4 L17;
C16 L29-L50] to defining a valid transaction. It would have been obvious at the time the
invention was made to a person having ordinary skill in the art to modify the disclosure
of Remington and include business rules to verifying the authorization to debit funds
within the parameters of the payment rules.

Re. Claims 5-6, and 28 Remington discloses wherein the payment method is selected
as a function of historical payment information for the payor or payee, and the payment
method is selected as a function of performance in previous transactions between the
payor and the payee [C2 L6-L67; C4 L48-L65].

Re. Claims 7-11, Remington discloses verifying the authorization of the payment
request, seeking payment approval if the payment request is unauthorized, and
executing the payment request only if approval is received from an entity having
approval authority, wherein the payor is an organization and payment approval is
sought by communicating payment information to one or more agents of the payor,

wherein payment approval is sought by communicating payment information to a predetermined list of payment approvers, wherein the payment request is executed if any payment approver provides approval, and wherein the payment information is executed to the predetermined list of payment approvers serially [Abstract; C5 L65 to C6 L33; C15 L1-L17; C7 L43 to C8 L50; C12 L1-L17; C4 L57-L65].

Re. Claims 12-13 and 16, 29, 30, 32 Remington discloses enrolling the payor by receiving payor identifying information and payor enrollment information, and verifying the ability of the payor to make payments [C14 L23 to C15 L41], wherein the identifying information comprises the name of the payor and a financial account number of the payor [C9 L7-L38], and wherein the plurality of payments are aggregated from transactions completed at a plurality of different marketplaces [C12 L1-L8; C16 L14-L34].

Re. Claim 14, Remington, Chevychase or Kolling does not explicitly disclose wherein the verification is performed by an independent credit rating service. However, this step is will known to credit card holder and financial institutions to check the applicant's ability for payment. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Remington and include credit rating verification to avoid losses occurs due to non-payments by consumers with bad credit ratings.

Re. Claims 15, 31 Remington discloses reporting to the payor the status of a plurality of payments [C1 L36 to C2 L45; C3 L35 to C4 L15-L56].

Re. Claims 17-22, 33-38, Remington discloses wherein the first payment is made in response to an automatic triggering event (activate pay button) [C8 L17-L33; C13 L10-L32; C15 L57 to C16 L2], wherein the triggering event is generated upon an exchange of goods or services that correspond to the payment request [C1 L10-L15], wherein the triggering event is generated upon the expiration of a predetermined period of time [C1 L36-L45], wherein the triggering event causes the first payment to be made at a different time than the second payment [C1 L10 to C2-L67], wherein the triggering event is a function of the payor's current account position [C1 L10 to C2-L67], and wherein the triggering event is a function of the payor's current account position and the payee's current account position [C1 L10 to C2-L67].

Re. Claims 23, and 39, Remington does not explicitly disclose debiting an account owned by the payor for the amount of a transaction fee for executing the payment request. However, Kolling discloses this feature [C11 L50-L67] to finance the cost of operating the payment network. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Remington and Kolling and add debiting transaction fee to compensate for providing electronic bill payment services.

Re. Claim 40, Claim 40 is rejected with same rational as claims 1 & 24.

Re. Claims 41-44, Claims 41-44 are rejected with same rational as claims 2-6.

Re. Claim 45, Claim 45 is rejected with same rational as claim 15.

Re. Claims 46-49, Claims 46-49 are rejected with same rational as claims 17-22.

Re. Claim 50, Claim 50 is rejected with same rational as claims 2-4, where payment methods are the same or not are business choices to reduce the cost, make it easy, etc.

Re. Claims 51-56, Remington discloses a request interface that receives a payment request containing payment information [C5 L40-52], a payment selector that is programmed to configure a payment transaction by selecting a payment method from a first set of payment methods as a function of the payor information and the payment request [Abstract; Figures 4-5; C6 L10-L23; C2 L35-L57; C15 L1-L17; C15 L42-L67; C19 L12 to C20 L55], and a payment processor that executes payment by the selected payment method [C8 L51-L66]. Remington does not explicitly disclose a database of payor information, wherein the database of payor information comprises payment selection rules, and wherein the payment selector selects a payment method independently of a payment method selected for the payee, and wherein the payment selector selects a payment method from a predetermined set of payment methods, and

wherein the payment selector selects a payment method by applying a predetermined

function to the payment information and comparing the result of the function to a

predetermined result, and wherein the predetermined function compares the monetary

value of the payment to an array of monetary values. However, Kolling discloses these

steps [see claim 1 and Fig. 3 # 82, Fig. 11 # 254, # 260; C4 L60 to C5 L12; C10 L24-

L50] for authorization and to accommodate differing consumer preferences. It would

have been obvious at the time the invention was made to a person having ordinary skill

in the art to combine the disclosures of Remington and Kolling to provide database with

consumer preferences and record.

Re. Claim 57, Remington discloses a payment approval verifier that determines whether

the payment authorization request is valid and seeks payment approval if the payment

authorization request is invalid [Abstract; C5 L65 to C6 L33; C15 L1-L17; C7 L43 to C8

L50; C12 L1-L17; C4 L57-L65].

Re. Claim 58, Claim 58 is rejected with same rational as claim 1.

Response to Arguments

2.   Applicant's arguments with respect to pending claims have been considered but

are moot in view of the new ground(s) of rejection.

Regarding Applicant's argument that In response to applicant's argument that

there is no suggestion to combine the references, the examiner recognizes that

obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references are for electronic bill payment system that allows the customer to pay the bill automatically using the computer and Internet.

Conclusion

4.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the

references fully when responding to this action.

US 5,878,141 to Daly et al, Mar. 2, 1999 "Computerized purchasing

system and method for mediating purchase transactions over an interactive

network" discloses This invention relates to computerized purchase systems and

methods for electronically transacting a purchase of goods and/or services

between a purchaser and a merchant. The invention further relates to such

purchase systems and methods for facilitating purchase transactions over an

interactive network, and particularly, in an interactive television system, and a

common set of available payment methods.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Harish T. Dass whose telephone number is 571-272-

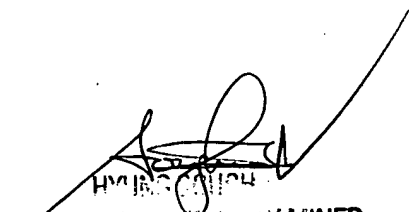6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass
Examiner
Art Unit 3628

9/7/05

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600